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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/310,965	05/13/1999	STAN SCHALL JR.	156.0001	9612

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CAHN & SAMUELS LLP
2000 P STREET NW
SUITE 200
WASHINGTON, DC 20036

EXAMINER

YU, JUSTINE ROMANG

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/310,965

Applicant(s)

SCHALL, STAN

Examiner

Justine R Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 5, 11, 12 and 17-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 10, 13 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9, 15, 16, 21, and 22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

1. This office action is responsive to the amendment filed on 9/16/02. As directed by the amendment, claim 15 was amended, no claim was canceled, and claim 22 was added. Thus, claims 1-22 are presently pending in this application.

2. Applicant's election of species 1 in Paper No. 10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

This application contains claims 5, 11, 12, and 17-20 drawn to an invention nonelected species. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, lines 2-3 "with the horizontal plane" is not clear as how and by what structural element being used to define the horizontal plane, and whether or not the "plane" is part of the invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Thomas, Jr. (4,768,778).

Thomas teaches an exercising device having an upper platform 34, a fist pad 88, a lower housing (36, 22, figure 3 and 5), a lower housing cap 44, a bearing element 48, and a regulating components 98.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, Jr..

Thomas in figure 9 shows a stopper (110, 114), the upper platform including a wall extending downwardly from a peripheral edge of a recess formed in the center of the upper platform, the wall has an opening passing therethrough, and the lower housing including an opening passing therethrough.

Figure 9 of Thomas differs from the present invention in that figure 9 of Thomas has bearing raceways (104, 118) rather than housing cap. However, the feature of choosing a

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housing cap rather than raceways is considered as an obvious design choice, see the housing cap (38, 44) in figure 3 of Thomas.

8. Claims 1-3, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas, Jr. in view of Montgomery (5,226,868) and Karstadt (Des. 141,456).

Thomas in figures 2 and 3 shows an upper platform (34, 88, 38) and a handle 26 supported by an upright (figure 2). Thomas's push-up device differs from the present invention in that Thomas's handle has a different shape rather than a handle having a short upright portion and a tall upright portion. However, Montgomery teaches a push-up device having a handle including a short upright portion 86, a tall upright portion 84, a gripping area 88 joint to the upright portions with elbows, see figure 6 of Montgomery. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Thomas's handle with a short upright portion, a tall upright portion, and a gripping area with elbows as taught by Montgomery, in order to provide an inclined support to the user.

The modified Thomas's gripping area lacks a tapered configuration such as tapered from the short upright portion to the tall upright portion. However, Karstadt teaches a handle including a tapered gripping area tapered from the proximal portion of the handle to the distal portion of the handle (figures 1 and 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified Thomas's handle with a tapered gripping area as taught by Karstadt, so as to be able to manipulate the device more easier.

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In addition, applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F. 2D 669, 149 USPQ 47 (CCPA 1966). Applicant must provide persuasive evidence to prove that the particular configuration of the claimed handle shape is significant.

Regarding claim 2, figure 6 of Montgomery shows the gripping area having an angled bottom and an arch 90. Montgomery lacks a detail description that the gripping area including a bottom angled at fourteen degrees with the horizontal plane. The feature of choosing a particular angle, i.e., fourteen degrees with the horizontal plane is considered as an obvious design choice since it appears that the modified Thomas's device would perform equally well with a fourteen degree angled gripping area. In addition, the feature of choosing a particular shaped tall upright portion, i.e., tapered out from the gripping area to the upper platform is considered as an obvious design choice since such shaped upright portion is well known in the art. See figure 2 of Karstadt's reference.

Regarding claim 21, the modified Thomas's reference lacks a description of a particular way to hold the handle such as by placing the pinkie of the user's hand on the gripping area near the tall upright portion. However, such method of holding the gripping area is considered as an obvious design choice. In addition, the modified Thomas's device has the same structure as claimed. If one of ordinary skill in the art, i.e., an exerciser, upon seeing the modified Thomas's device desired to perform the push-up exercise with various difficulty levels, one would have looked to the modified Thomas's device and seen that by holding the handle differently, i.e., placing the pinkie near the tall upright portion, would be able to provide varied difficulty levels of exercises.

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9. Claims 6, 7, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hovda (1,533,500).

Hovda teaches an exercise device having an upper platform 1, lower housing 2, the lower housing including a floor with a hole 4 passing therethrough, see teaching on page 1, lines 54-58 and figure 1, a lower housing cap 12, a bearing element 22, and regulating components (21, 19, 20) including adjustment mechanism 21 (nut, see teaching on page 1, lines 81-83).

Hovda has a dust plate covering the hole 4 while the present invention does not have a dust plate. The feature of choosing not to have the dust plate is considered as an obvious design choice because the omission of an additional element and its function is obvious if the function of the element is not desired.

Regarding claim 7, notes the friction material 19 which including threads for engaging the nut 21.

Regarding claim 9, figure 1 of Hovda shows the recited structure.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hovda in view of Titus (2,256,001).

Hovda lacks a footing attached to the lower housing. However, Titus teaches a footing 11 being attached to the lower surface of the lower housing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hovda's

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device with footing as taught by Titus, in order to prevent the device from slipping on the floor or support.

Allowable Subject Matter

11. Claims 4, 10, 13, and 14 are allowable over the prior art of record.

Response to Arguments

12. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive.

Applicant on page 2 of his remarks traversed to a non-existent 35 USC 112 (1) rejection. Notes that claim 2 is rejected under 35 USC 112 (2) because it is not clear as what is the structural element being used to define the horizontal plane.

13. The applicant on page 3 of the remarks correctly states that the "first pad" in the previous office action should read as --fist pad--. The typographical error has been corrected in this office action. Applicant argues that material 88 is a decorative material and should not be constructed as a fist pad since there is a handle. While it is true that Thomas discloses a handle for the user to hold or grab with, however, there has no basis to support the allegation that the user cannot put his fist on the pad 88. In response to applicant's argument that the pad 88 is not a fist pad, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use

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must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

On page 4, the second full paragraph of the remarks, applicant argues that Thomas are incapable of providing resistance and stopping power “to prevent the upper platform from rotating relative to the lower housing”. Notes that the function of “to prevent the upper platform from rotating relative to the lower housing” is irrelevant because the claim language does not support it. While bearing surfaces (110, 114) (stopper) make slidable contact with each other which stopping each other from disengagement (figure 9), bearing surfaces (110, 114) read on the claimed structure.

The applicant further argues that Thomas fails to teach the openings recited in claim 16. The examiner disagrees. Figure 9 of Thomas clearly shows a wall 112 having an opening passing there through. Thus, Thomas does disclose an opening.

The applicant on page 5 of the remarks states that Thomas has a handle extending along a second axis generally parallel to the plane of rotation of the platform which teaches away from a handle being angled relative to the plane of the rotation. While it is true that Thomas lacks a handle being angled relative to the plane of the rotation. This is why the examiner rejected the claims 1-3 and 21 under 35 USC 103(a). Applicant cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, a skilled artisan could have readily appreciated that Thomas’s handle being inclined in view of Montgomery teaching.

In response to applicant's argument that Karstadt is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a person of ordinary skill in the art could have readily appreciated that the combined Thomas and Montgomery reference could have a tapered gripping portion in view of Karstadt teaching.

In response to applicant's statement on page 6, the last paragraph of the remarks, figures 2 and 3 of Thomas clearly show the recited structure.

The applicant on page 7 of the remarks argues that the examiner provides no rationale as why one of ordinary skill in the art would change the placement of the pinkie given the teachings of Karstadt and Montgomery. The combined Thomas, Montgomery, and Karstadt reference discloses the same structure as claimed. It is the examiner's position that the way to grab the handle is merely a matter of design. If one of ordinary skill in the art, i.e., an exerciser, or even a child, upon seeing the modified Thomas's device, would be able to hold the modified Thomas's device with the pinkie near the tall upright portion if the exerciser or the child desired to change the level of difficulty during exercise.

The applicant on page 7 of the remarks states that "the office action fails to state a suggestion, motivation, or teaching for stating that nut 21, screw bolt 19, and head 20 should be considered to be regulating components as recited in claim 6". It is the examiner's position that the elements (19-21) could be able to perform the function as to regulate and control rotation between the lower housing and the upper platform since loosening or tightening the nut on the

bolt would change the friction force between the upper platform and the lower housing, thus, Hovda's elements (19-21) read on the claimed regulating components.

The applicant on page 8 of the remarks argues that Hovda teaches away from the combination of Hovda in view of Titus. The argument is not well taken because there has no basis to support the allegation that Hovda's disc 2 cannot have a footing. Indeed, the feature of having footing in exercise devices is notoriously old and well known in the art for preventing slippery.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justine R Yu whose telephone number is (703)308-2675. The examiner can normally be reached on 8:30am - 6:00Pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on (703)308-2698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.


Justine R Yu
Primary Examiner
Art Unit 3764

JY
November 13, 2002